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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/718,077 | 11/20/2003 | Dave Dickason | CP185B | 8643 |
| 27573 | 7590 | 08/09/2007 | EXAMINER | |
| CEPHALON, INC. 41 MOORES ROAD PO BOX 4011 FRAZER, PA 19355 | | | WILLIAMS, LEONARD M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 08/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|---------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/718,077 | DICKASON ET AL. |
| | Examiner Leonard M. Williams | Art Unit 1617 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 May 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 22-46 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/16/2004; 7/7/2005</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-21; species elected is the compound of claim 5) in the reply filed on 5/23/2007 is acknowledged. The traversal is on the ground(s) that there is no burden on the examiner for search purposes and that the classification is misplaced. This is not found persuasive because the examiner has clearly indicated the basis for the election restriction in the prior action. The classification of the inventions is based upon the standard practice of the USPTO. Further as applicant has elected the composition, the applicant has a right for rejoinder if the composition claims are found allowable.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakata et al. (WO 88/07045) in view of Matthews et al. (WO 00/48571).

Murakata et al. teach, in the abstract, derivatives of k-252 represented by formula I useful in formulating compositions having protein kinase C inhibiting activity. On page 43, Murakata et al. disclose that compounds of formula I can be administered as oleophilic and hydrophilic salts and can be dissolved in solution for administration in a dose of 0.01-20 mg/kg. Oral and rectal administration are also contemplated. Compound 20 in Table 2 (pages 45-46) discloses the currently claimed species.

Murakata et al. does not teach the compound in at least 20% (w/w) of a poloxyl stearate ; and at lweast one polyethylene glycol ; or the particular concentration as

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claimed, or polyethylene glycol having a particular weight; or the use of Myrj52; or the various ratios of the polyethylene glycol:polyoxyl sterate etc..

Matthews et al. teach, in the abstract, spontaneously dispersible N-benzoyl-staurosporine compositions (a closely related compound to the one presently claimed) for oral administration having high bioavailability. On page 4, Matthews et al. teach that the N-benzoyl-staurosporine (active agent) can be present up to 20% by weight of the composition, can have a hydrophilic component and a surfactant and that the hydrophilic component can be lower alkanol components such as polyethylene glycols of 100-600 daltons. The total amount of the hydrophilic component is 5-50% by weight. On pages 5-7, Matthews disclose that the pharmaceutical compositions comprise at least one surfactant that includes polyoxyethylene fatty acid esters, such as polyoxyethylene stearic acid esters sold under the trade name MYRJ. MYRJ 52 being particularly preferred. Other commercially available surfactants include Solutol HS15 and MEF 151E. These contain polyethoxylated hydroxystearate and polyethylene glycol mixtures.

Matthews et al. teach, on page 13, that the pharmaceutical compositions disclosed exhibit higher levels of oral bioavailability compared to previous compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the compounds of Murakata et al. in the pharmaceutical compositions of Matthews et al. as the compounds disclosed in both are structurally related and have the same biological target of protein kinase C inhibition. One would be

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motivated to use Matthews et al. formulation in order to take advantage of the increased oral bioavailability disclosed.

One of ordinary skill in the art would have been motivated to adjust the ratios of fatty acid esters and polyethylene oxide in order to maximize the formulations bioavailability.

The examiner respectfully points out the following from MPEP 2144.05: "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); see also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed.Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard M. Williams whose telephone number is 571-272-0685. The examiner can normally be reached on MF 9-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LMW



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER